

**REMARKS**

The Office Action mailed May 3, 2003 has been received and reviewed. Claims 1-34, and 38 are pending in the application. By way of the present amendment, claims 1, 18, 22, 26, 28, 29, and 35 are amended. Claims 1-14, 16, 18-23, 25-29, 31-34, and 38 stand rejected and claims 15, 17, 24, and 30 objected to as dependent on a rejected base claim. Applicant notes with appreciation that claims 35-37 were allowed. The application is to be amended as previously set forth. Claims 22 and 38 are to be canceled. All amendments and claim cancellations are made without prejudice or disclaimer. Reconsideration is respectfully requested.

**1. Interview**

Applicant found the interview of June 24, 2003 very useful and thanks Examiners Kontos and Casler for the opportunity to discuss the application and invention.

**2. Drawing**

As discussed at the interview, a new drawing (FIG. 6) is proposed to be added. Support for FIG. 6 can be found generally throughout the application, but specifically, by statements, for instance, found in original specification version paragraph [0071] wherein it is described, "the described devices can be easily modified such that the electrical potential between the first and second electrodes is created by forming the electrodes of electrochemically active materials, thus establishing an electrochemical galvanic cell. In this embodiment, an external power supply is unnecessary". Additional support for FIG. 6 can be found, specifically, in original and current versions of claims 1 and 35. FIG. 6 merely repeats FIG. 2, but has the battery removed.

Paragraph [0071] is to be amended to reference the new figure, and paragraph [0032.1] is to be added referencing the new figure.

### **3. Claim Rejections under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph**

Claims 22 and 26 were rejected under 35 U.S.C. § 112, second paragraph, for assertedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention.

Specifically, claims 22 and 26 were rejected for lacking antecedent basis with regard to the term “said first electrode.” Claim 22 has been canceled, thus obviating the need to respond to that aspect of the invention. Claim 26 has been amended by substituting the words “plurality of mutually spaced apart electrodes” for the words “first electrode.” Accordingly, the rejection is believed to have been overcome. Reconsideration and withdrawal of the rejection are respectfully requested.

### **4. Claim Rejections under 35 U.S.C. § 102(b):**

Claims 1-4, 6-12, 14 and 16 were rejected under 35 U.S.C. § 102(b) as assertedly being anticipated by Haak *et al.* in US Patent 5,445,606 (“Haak”). Applicant respectfully traverses the rejection.

As discussed at the interview, Haak is silent with respect to the elements of applicant’s electrotransport device serving as a “battery” as claimed in independent claim 1. As claimed in these particular claims, applicant’s invention uses elements of the electrotransport device to form a battery. For instance, independent claim 1 claims an electrotransport device “. . . wherein said first electroactive material is electropositive or electronegative and wherein said second electroactive material is electronegative or electropositive, respectively, such that when electrically connected with said conductor and said ionic fluid, *a battery is formed*” (emphasis added). Haak does not disclose such an orientation. Accordingly, reconsideration and withdrawal of rejections of the rejected claims are respectfully requested.

### **5. Claim Rejections under 35 U.S.C. § 103(a)**

Claims 5, 13, 18-23, 25-29, and 31-34 were rejected under 35 U.S.C. § 103(a) for assertedly being obvious to one of ordinary skill in the art in light of the Kühl, *et al.* US Patent 4,140,122 (hereinafter referred to as “Kühl”) in combination with the Haak. Specifically, it was

thought that while "Haak, *et al.* teaches an electrotransport device . . . used for transdermal iontophoresis," Kühl teaches "an implantable dosage device with two electrodes and membrane for ion exchange" requiring an electric current to transmit the beneficial agent from a reservoir into a patient. (Office Action, pages 3-4). It was asserted that implanting Haak device to transmit a beneficial agent to internal tissues would be obvious to one of ordinary skill in the art. Applicant respectfully traverses the rejections.

Haak and Kühl are both silent with respect to the elements of the electrotransport device forming a power source as required by independent claims 1 and 35 and the claims dependent thereon. The specification teaches an electrotransport device wherein the elements of the device act as a battery. For instance, claim 1 claims an electrotransport device ". . . wherein said first electroactive material is electropositive or electronegative and wherein said second electroactive material is electronegative or electropositive, respectively, such that when electrically connected with said conductor and said ionic fluid, *a battery is formed*" (emphasis added). As neither Haak nor Kühl teach or suggest such a device, it is requested that the rejection be withdrawn.

Independent claims 18 and 27 and the claims dependent thereon relate to an implantable electrotransport device wherein the subject's tissue completes a circuit between the electrodes thus enabling the delivery of drug to the subject (*see, e.g.*, paragraphs [0068]-[0070] of the specification as-filed and the associated Figure drawings). Neither Haak nor Kühl are believed to teach such an element or device and, accordingly, it is respectfully requested that the obviousness rejection based on these references be withdrawn.

Claim 38 was also rejected as being obvious in view of Haak in view of Lloyd. Claim 38 has been canceled thus obviating the need to respond to the rejection.

Conclusion

In view of the present amendments and remarks, the remaining claims are believed to be in condition for allowance and an early notice thereof respectfully is solicited. Should the Office determine that additional issues remain which might be resolved by a telephone conference, the Office respectfully is invited to contact applicant's attorney at the address or telephone number given herein.

Respectfully submitted,



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Date: September 2, 2003

Attachment: FIG. 6

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